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In the Drawings:

Pursuant to the Examiner's request, Applicant submits herewith replacement sheets of the drawings and labeled as "Replacement Sheet".

(1) In Figure 1, the lead line from reference numerals 108 and 120 have been extended to further clarify what is meant by "outlet portion" and "outer skirt" respectively.

(2) The lead line on Figure 2 for reference numeral 120 has been extended to further clarify what is meant by the "outer skirt".

(3) The lead line on Figure 3 for reference numeral 108 has been extended to further clarify what is meant by "outlet portion".

This Examiner has objected to the drawings under 37 CFR 1.84(p)(4) as follows:

(1) Reference numeral 108 and 105b both designate "outlet portion".

The reference numeral 108 is referred to in the specification as "The outlet portion 108 can comprise e.g. a head assembly 104 with an integrally formed conduit 105 that is shaped as a bent elbow with entrance and discharge portions 105a and 105b, respectively, that extend at an angle X relative to each other." The Specification clearly refers to 105b as a discharge portion. Further, the amended drawings show reference numeral 108 extending

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to the outlet portion while lead line for 105b clearly indicates the discharge portion of the conduit 105.

(2) Head assembly 104 and outlet portion 108 appear to be the same structure.

The outlet portion 108 specifically includes the head assembly 104 which is indicated in the drawings.

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## REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following discussion.

In the Amendment

The Examiner has objected to the Amendment filed on 30 November, 2005 under 35 U.S.C. 132(a) because it introduces new matter.

(1) page 2, lines 4-5 of the Amendment filed on 13 March, 2006 describes "[a]n apparatus for separating debris from rock on a surface free of standing water".

Claim 1, Claim 13 and Claim 17 were amended in the Supplemental Amendment, filed 28 March 2005, (hereinafter referred to as "Supplemental Amendment 2005"), to include "a landscape surface that is directly exposed to the atmosphere". At that time, no objection was raised to this amendment regarding new matter. Further, even though these claims were later cancelled, the addition of the language "surface free of standing water" is just further clarification of the landscape surface directly exposed to the atmosphere.

Cancellation of disclosure material, without more, does not establish abandonment. Further, "a mere change in descriptive

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terminology does not amount to the addition of 'new matter' " O'Hara Manufacturing, Ltd. V. Eli Lilly & Co., 231 USPQ 753, 761 (N.D. Ill. 1986).

(2) The Examiner has objected to the statement "to facilitate advancing in a slightly raised position above the surface to permit the introduction of air, debris and rock into the intake portion whereupon any debris lighter than rock will be drawn upwardly through the outlet portion into the vacuum source and any rock lifted from the surface will return to the landscape surface" as new matter.

The Provisional Patent Application filed on August 28, 2002, and incorporated by reference into this application when it was filed (hereinafter referred to as "Provisional Application"), describes on page 2, a device that "removes debris and dirt from the surface, but enables the landscape to be separated from the debris and dirt and redeposited on the landscape surface as part of the cleaning process." Further, Page 3 of the Provisional Application sets forth "provision of more than one handle enables the cleaning device to be conveniently held by an operator in an advantageous position for cleaning a landscape surface 114, in the manner contemplated by the present invention." Page 4 of the Provisional Application describes "the intake portion 106 oriented downward with the distal end 116 in close proximity to the landscape surface 114, so that the distal end 116 is essentially in contact with the landscape surface 114."

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Still further, Page 5 of the Provisional Application sets forth "The narrowing flow passage 120 causes the air flowing through the outlet 108 to accelerate and any dirt and debris that is relatively small in mass is likely to be carried through the flow passage 108 along with the fluid flow through the flow passage 120. However, if any landscape rock is drawn into the intake portion 106 along with the dirt and debris, the size of the intake portion 106, the mass of the landscape rock, and the angle X at the bend 122 between the intake and outlet portions makes it more difficult for the landscape rock to pass from the intake portion 106 to the outlet portion 108 of the conduit 104."

Clearly, the original disclosure not only specifically discloses the portion objected to by the Examiner, but the device inherently operates in the fashion described. The orientation of the handles, as described in the Provisional Application as well as the description of operation of the device further supports the argument that this is not new matter. Finally, the claim language has been amended to reflect the device being oriented along the surface.

(3) The Examiner has objected to "or any other type of vacuum power source" as new matter. The language has been amended to "a wet/dry vacuum source", consistent with the original disclosure.

(4) The Examiner has objected to the inlet portion 105a "extending centrally through" as new matter. This material is clearly shown in the drawings filed with the Patent Application filed on 26

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August, 2003, (hereinafter referred to as Patent Application"). The term "centrally through" merely conforms the specification to that which is shown in the drawings. Triax Co. V. Hartman 178 USPQ (2 CCA 1973).

(5) The Examiner has objected to the statement that handles 110 and 112 "facilitate advancement of the apparatus in a slightly raised position above the surface to permit the introduction of air, debris and rocks into the intake portion 106" as new matter. Page 5 of the Patent Application, lines 20 through about 24 discuss "Air carrying dirt and debris is drawn into the intake portion 106 and through the conduit 105." Further, the Supplemental Amendment 2005, describes in Claim 1: a. "A device for cleaning a landscape surface that is directly exposed to the atmosphere", and b. the conduit system being configured to (i) enable the intake portion to be held in a downward orientation toward the surface of the landscape with the intake opening disposed against the surface of the landscape, and (ii) allow atmospheric air that is about the landscape surface, landscape rock, dirt and debris to be drawn into the intake portion...". The language contained in the Patent Application clearly covers the recitation; and further the fact that the function is inherent in the disclosure and makes "explicit a disclosure which was implicit in the application as filed." Tektronix Inc. vs. U.S. 165 USPQ 392, 394 (Ct. Cl 1971).

(6) The Examiner has objected to "the handle 110 extends parallel to the longitudinal axis of the intake portion 106 and handle 112 extends at an angle to it" as new matter. This particular

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structure is clearly shown in the drawings filed with the Provisional Application as well as the Patent Application. The orientation of the handle 110 is clearly shown in Figure 2 of the Patent Application and is not new matter. Handle 112 is also shown in the drawings. The decisions make clear that the specification and drawings may be amended to conform to each other. In re Heinle, 45 USPQ 131 (CCPA 1965).

(7) The Examiner has objected to "[t]he head assembly 104 also includes an end portion 113 extending centrally through an end wall 118a into fluid communication with the interior of the intake portion 106" as new matter. Once again, this particular feature was shown in the original drawings and is clearly not new matter for the reasons given in paragraph 6 above.

(8) The Examiner has objected to "[n]ecessarily, the intake portion 106 is of a length substantially greater than that of the outlet portion 108" as new matter. Exhibit A and B, submitted with the Provisional Application clearly show that the length of the intake portion is substantially greater than that of the outlet portion. Clarification of matter already disclosed is not considered to be new matter.

(9) The Examiner has objected to "[t]he combination of the intake portion 106 and the outlet portion 108 is of a length to extend to the waist level of a user" as new matter. Page 4 of the Provisional Patent Application describes this feature as follows: "provision of more than one handle enables the cleaning device to

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be conveniently held by an operator in an advantageous position for cleaning a landscape surface 114 in the manner contemplated by the present invention" and also discusses "the cleaning device is held by one or both handles 110, 112 in an orientation portion 106 oriented downward from the distal end 114 in close proximity to the landscape surface. " Further, Exhibit A and B which were included with the Provisional Application clearly demonstrate the dimensions of the device.

(10)and (11) The Examiner has objected to the "newly added structure" of handle 112 shown on the Replacement Sheet of Figure 1 and Figure 3, as new matter. The drawing of the handle was clarified at the request of the Examiner in the Office Action dated 7/28/05. The handle 112 has always been shown in the drawings and is not an addition of new matter.

This Examiner has rejected Claims 22-34 based on new matter. If the amendment does no more than conform the written description to that which is clearly shown in the drawings, then insertion of the supplemental material into the specification should be allowed. Confirmation of one portion of the disclosure to another portion thereof is clearly permissible. M.P.E.P. §2163.06.

### Claim 22:

The Examiner has rejected the claim language "including an end



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portion extending centrally through said end wall" as constituting new matter.

Reference numeral 105a is described as an inlet portion which is in direct fluid communication with the intake portion 106. (Patent Application, page 4). The end portion 105a is clearly described in the Patent Application Specification and shown in the drawings of Figure 2. The terms "extending centrally through" only clarify what was previously disclosed. Further, the original drawings clearly show an end wall in Figure 3. Claim 22 has been amended to delete the term "centrally".

The Examiner has rejected the claim language "to facilitate advancement in a slightly raised position along said surface to permit the introduction of air, debris and rock into said intake portion" as constituting new matter.

Page 5 of the Provisional Application sets forth "Air carrying dirt and debris is drawn into the intake portion 106 and through the conduit 105." Further, the Supplemental Amendment 2005, describes in Claim 1: "A device for cleaning a landscape surface that is directly exposed to the atmosphere", and

b. the conduit system being configured to (i) enable the intake portion to be held in a downward orientation toward the surface of the landscape with the intake opening disposed against the surface of the landscape, (ii) allow atmospheric air that is about the landscape surface, landscape rock, dirt and debris to be drawn into the intake portion...".

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As is demonstrated from the foregoing, if the device were to be held flush against a surface, atmospheric air about the landscape surface would not be drawn into the intake portion. The amendment to the claim merely clarifies a feature of the device that was set forth previously. Further, the claim language has been amended, substituting along for above.

**Claim 23:**

The recitation that the intake portion and the outlet portion in combination "are of a length to extend substantially to the waist level of a user" is considered new matter.

This claim has been canceled.

**Claim 25:**

The recitation that the first handle member extends "parallel" to a longitudinal axis of the intake portion is considered to be new matter.

Figure 1, Figure 2 and Figure 3 of the original drawings filed with the Patent Application clearly show a first handle member extending parallel to a longitudinal axis of the intake portion. Further, the Specification describes a rear handle 110 connected to the outlet portion 108.

**Claim 26:**

The recitation that "said second handle member extends at an angle to said first handle member" constitutes new matter.

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The Provisional Application, Page 3, describes a pair of handles 110, 112. "The handles are secured to the exterior of the cleaning device....Provision of more than one handle enables the cleaning device to be conveniently held by operator in an advantageous position for cleaning a landscape surface 114". The description of the second handle member simply clarifies what was disclosed and shown in the original drawings. This claim has also been amended.

### Claim 27:

The recitation that the handle members "are located on said intake and outlet portions" constitutes new matter.

The Provisional Application clearly sets forth "A rear handle 110 is connected with the outlet portion 108. A front handle 112 is connected to a location on the intake portion 106". Figures 1, 2 and 3 of the Provisional Application clearly show the location of the dual handles. This claim has been amended.

### Claim 29:

The recitation that "said intake portion is at least twice as long as said outlet portion" constitutes new matter.

Exhibit A and B, submitted with the Provisional Patent Application clearly show that the length of the intake portion is substantially greater than that of the outlet portion. All drawings also demonstrate the difference in length between the intake portion and the outlet portion. Clarification of matter already disclosed is not considered to be new matter.

**BEST AVAILABLE COPY****Claim 31:**

The recitation that "said first diameter being almost twice as great as said second diameter" constitutes new matter.

The Patent Application, on page 5, describes "the conduit 105 has a smaller inside diameter 119 than the inside diameter 121 of the inlet portion 106." Further, Page 7 describes preferred dimensions of the inner diameter 121 of intake portion 106 as between 3.75 inches to 4.75 inches to about 6 inches. Conduit 105 having an inner diameter 119 of about 2 inches and up to 3 inches. "In either version, it is contemplated that the inner diameter 119 of the conduit 105 will be smaller than the inner diameter 121 of the intake portion 106." The matter added to this claim is clearly not new matter.

**Claim 31:**

The Examiner has rejected of "a means for deflecting rocks from entering said outlet portion" as new matter.

The Patent Application on Page 5 describes the method of separation between landscape rock and dirt and debris. "However, if any landscape rock is drawn into the intake portion 106 along with the dirt and debris, the size and orientation of the intake portion 106 and the mass of the landscape rock makes it more difficult for the landscape rock to pass from the intake portion 106 to the conduit 105." Further, Figure 3 clearly shows an end wall 118a that allows for deflection of landscape rocks.

**BEST AVAILABLE COPY****Claim 31:**

The Examiner has rejected "being of a length to extend to the waist level of a user" as new matter. This claim has been canceled.

**Claim 33:**

The recitation that "a diameter of said open entrance end is equivalent to a diameter of said opposite end wall" is considered to constitute new matter.

Figure 3 of the original drawings clearly demonstrates that the diameter of the open end 118 is equivalent to the diameter of the opposite end wall 118a. It is shown in the drawings and is clearly not new matter.

The recitations that were added in the Amendment are amplifications and explanations of what was already presented in the original application and should not be considered new matter.

Claims 22 through 34 are rejected under 35 U.S.C. 112, second paragraph.

Claim 22: The Examiner has taken the position that the recitation of "any debris" is vague. Claim 22 has been amended to overcome the rejection.

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Claim 22: The Examiner has taken the position that the recitation of "rock" and "any rock" is vague. Claim 22 has been amended to overcome the rejection.

Claim 22: The Examiner has taken the position that the recitation "the landscape surface" is vague and lacks antecedent basis. Claim 22 has been amended to overcome the rejection.

Claim 23: The Examiner has taken the position that the recitation that the intake portion and outlet portion in combination "are of a length to extend substantially to the waist level of the user" is vague. This claim has been canceled.

Claim 25: The Examiner has taken the position that "a first handle member" is vague. This claim has been amended to overcome the rejection.

Claim 26: The Examiner has taken the position that "a second handle member" is vague. This claim has been amended to overcome the rejection.

Claim 26: The Examiner has taken the position that the recitation of a second handle member extends "at an angle to said first handle member" is vague. This claim has been amended to overcome the rejection.

Claim 27: This claim has been amended to reflect the Examiner's suggested language.

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Claim 28: The Examiner has rejected to the language in this claim referring to a pressure state that is created within said intake portion. This property is inherent in the original disclosure.

Claim 29: The Examiner has taken the position that the recitation "said intake portion is at least twice as long as said outlet portion" is vague and not supported by the original disclosure. This feature is supported in the specification and drawings. Exhibit A and B, submitted with the Provisional Application clearly show that the length of the intake portion is substantially greater than that of the outlet portion. All drawings also demonstrate the difference in length between the intake portion and the outlet portion. Clarification of matter already disclosed is not considered to be new matter.

Claim 30: This claim has been amended to overcome the rejection.

Claim 31: This claim has been amended to overcome the rejection.

Claim 31: The Examiner has taken the position that the first diameter of the intake portion is "almost twice as great as" the second diameter of the outlet portion, is vague. The Patent Application, on page 5, describes "the conduit 105 has a smaller inside diameter 119 than the inside diameter 121 of the inlet portion 106." Further, Page 7 describes preferred dimensions of the inner diameter 121 of intake portion 106 as between 3.75 inches to 4.75 inches to about 6 inches. Conduit 105 having an inner diameter 119 of about 2 inches and up to 3 inches. "In either

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version, it is contemplated that the inner diameter 119 of the conduit 105 will be smaller than the inner diameter 121 of the intake portion 106." The disclosure is clearly supported by the specification and the drawings.

Claim 31: The Examiner finds "means for deflecting rocks from entering said outlet portion" is vague.

The Patent Application on Page 5 describes the method of separation between landscape rock and dirt and debris. "However, if any landscape rock is drawn into the intake portion 106 along with the dirt and debris, the size and orientation of the intake portion 106 and the mass of the landscape rock makes it more difficult for the landscape rock to pass from the intake portion 106 to the conduit 105." Further, Figure 3 clearly shows an end wall 118a that allows for deflection of landscape rocks.

Claim 31: The Examiner finds that the recitation "being of a length to extend to the waist level of the user" is vague. This claim has been canceled.

Claim 31: The Examiner has taken the position that the recitation of "means for grasping and maneuvering said intake portion and said outlet portion in the hands of a user to facilitate advancement and positioning of said apparatus on the landscape surface" is vague. The claim has been amended to overcome the vagueness rejection.

Claim 33: The Examiner finds the language concerning the diameters



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of the open entrance end to be vague. This claim has been amended to overcome the rejection.

Claimed 34: The Examiner finds the recitation of "at substantially right angles" to be vague. This claim has been amended.

**Claim Rejections - 35 U.S.C. § 102**

Claims 22 through 28 and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Bunch.

The Examiner has taken the position that Bunch covers "an elongated tubular intake portion (20/18) of a first diameter having an open entrance end (36) and an opposite end wall (30). Also, that Bunch covers "an elongated tubular outlet portion (34) of a second diameter of said intake portion (20/18)".

Claim 22 has been amended to more clearly reflect applicant's device. Applicant's device has a single open entrance end and an end wall, excluding any openings between said open entrance end and said end wall. This is clearly distinguishable from Bunch. Bunch's device possesses an inlet manifold 52 and manifold apertures 56 that are specifically designed to break up gravel clusters by injecting water radially into Bunch's upper housing 18. Bunch is also not a closed system, having a manifold that allows for the entry of external water. Further, Bunch does not teach an intake portion having a first constant diameter throughout the

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intake portion and an outlet portion having a second, smaller diameter throughout. Bunch's conduit sections 18 and 20 have substantially different cross-sectional areas, for reasons expressly described in Bunch, Column 1, lines 59-63, Column 2, lines 47-50, Column 4, lines 3-15. Bunch has a smaller diameter intake portion so as to limit the size of the gravel clusters entering the upper housing. There is no suggestion or teaching in Bunch to reverse the configuration to applicant's invention.

The Examiner also takes the position that an end portion of the outlet 34 of the apparatus of Bunch extends centrally through the end wall 30 by virtue of its being located along a central axis of end wall 30. Bunch does not have an end portion extending centrally through the end wall of the intake portion. Further, claim 22 has been amended to more clearly reflect applicant's device.

The Examiner considers the lid 30 of Bunch to read on applicants "head assembly" language so that the structure of Bunch meets the claim language of "the outlet portion 34 is disposed in the head assembly 30 configured for attachment to the intake portion 20/18 with the outlet portion 34 in direct fluid communication with the inlet portion 20/18."

Claim 23: Canceled.

Claims 24, 25 and 26 have been amended to more clearly reflect applicant's device. Bunch does not teach a handle member that is

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parallel to a longitudinal axis of the intake portion. Further, Bunch does not teach a second handle member aligned in a perpendicular plane to the first handle member.

Claim 27: This claim has been amended to address the Examiner's concerns.

Claim 28: It is respectfully submitted that Bunch does not create a pressure state similar to that of applicant's device. The presence of the manifold in Bunch as well as the difference in cross-sectional areas, acts to decrease the velocity of fluid entering the larger outlet portion.

Claim 30: Bunch clearly does not teach a device having an end wall that acts as a deflection surface to separate debris from rocks. The lid of Bunch does not function as a deflection surface, it is the "radially directed fluid" from the manifold that breaks up gravel clusters.

**Claim Rejections - 35 U.S.C. § 103**

Claims 29 and 31 through 34 are unpatentable over Bunch.

Applicant's device has a single open entrance end and an end wall, excluding any openings between said open entrance end and said end wall. This is clearly distinguishable from Bunch. Bunch's device possesses an inlet manifold 52 and manifold apertures 56 that are specifically designed to break up gravel

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clusters by injecting water radially into Bunch's upper housing 18. Bunch is also not a closed system, having a manifold that allows for the entry of external water.

Further, Bunch does not teach an intake portion having a first constant diameter throughout the intake portion and an outlet portion having a second, smaller diameter throughout. Bunch's conduit sections 18 and 20 have substantially different cross-sectional areas, for reasons expressly described in Bunch, Column 1, lines 59-63, Column 2, lines 47-50, Column 4, lines 3-15. Bunch has a smaller diameter intake portion so as to limit the size of the gravel clusters entering the upper housing. There is no suggestion or teaching in Bunch to reverse the configuration to applicant's invention.

Bunch fails to teach that the intake portion is at least twice as long as the outlet portion. The Examiner is claiming that changes in size/proportion do not constitute patentable subject matter. A device having the claimed dimensions of Bunch would not be operable for applicant's purposes.

Claim 31: Bunch fails to teach a constant diameter throughout the intake portion. This element is critical to applicant's device and is not simply a change in size or proportion.

Claim 32: Bunch fails to disclose that said outlet portion is substantially elbow shaped. This feature is important to operation of Nelson and not present in Bunch.

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Claim 33: This claim has been amended pursuant to the Examiner's suggestion.

Claim 34: This claim has been amended to more clearly reflect applicant's device.

The Commissioner of Patents and Trademarks is hereby authorized to charge any additional claim fee which may be due to Deposit Account No. 18-0875.

This Amendment is submitted in response to the Final Office Action of 26 September, 2006. It is therefore urged that the claims as now presented for consideration are in allowable condition and action to that end is courteously solicited. An interview has been scheduled for December 1, 2006 at 2:00 p.m. (EST).

Respectfully submitted,



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### CERTIFICATE UNDER 37 C.F.R. 1.8

I hereby certify that the foregoing Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP: AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 27th day of November, 2006.

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